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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAY PAUL DRUMMOND, BOB A. CICHON,
MARK D. SMITH, DAVID WEIS, JAMES R. CHURCH,
and MIKAL R. GILGER

Appeal 2008-1839
Application 09/578,291
Technology Center 3600

Decided: ¹ June 1, 2009

Before: MURRIEL E. CRAWFORD, ANTON W. FETTING, and JOSEPH
FISCHETTI, *Administrative Patent Judges.*

CRAWFORD, *Administrative Patent Judge.*

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 (2002) from a non-final rejection of claims 1 to 32. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

Appellants invented an automated banking machine apparatus and system that is capable of use in a wide area network (Spec. 1).

Claim 1 under appeal reads as follows:

1. A method comprising the steps of: a) determining through operation of an automated banking machine, data corresponding to an entity with which a customer operating the machine has an account; b) providing through an output device on the automated banking machine at least one output uniquely corresponding to the entity with which the customer has the account.

The prior art relied upon by the Examiner in rejecting the claims on appeal are:

Anderson	5,706,442	Jan. 6, 1998
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LA Times Staff Writers, *Trade it Yourself Bank Machines Make a Debut*, L.A. Times, Oct. 6, 1994, (Home Edition Business Section) at 1 Pt. D, Col. 5.

Leon, Mark, *TP-Monitor Vendors Spin Web Features*, InfoWorld v18n27 Jul. 1, 1996 at 37.

The Examiner rejected claims 1 to 32 under 35 U.S.C. § 102(b) as being anticipated by or in the alternative under 35 U.S.C. § 103 as obvious over LA Times.

The Examiner rejected claims 1 to 32 under 35 U.S.C. § 103(a) as being unpatentable over LA Times in view of Infoworld or Anderson.

ISSUES

The Appellants contend that the Examiner's finding that the Citibank ATM described in LA Times is considered to possess all normal components and component interrelationships of an ATM machine is based on improper speculation. The first issue is: have Appellants shown that the Examiner erred in finding that LA Times inherently discloses an ATM that determines data corresponding to an entity with which a customer has an account and provides at least one output uniquely corresponding to the entity and is able to provide account access, transfer funds and dispense statements?

The second issue is: have the Appellants shown that the Examiner erred in finding that Infoworld and Anderson disclose a browser in operative connection with an ATM?

FINDINGS OF FACT

LA Times discloses that Citibank is offering full-scale brokerage services on ATM machines that will be used for banking and for brokerage services. The Citibank ATMs have separate menus for banking and brokerage services. LA Times also discloses that Wells Fargo allowed customers using ATMs to buy and sell proprietary mutual funds and that Wells Fargo chose not to provide stock quotes and other trading options because the bank was concerned that the ATM lines would be clogged with customers checking stock prices. Citibank is not concerned about this problem. The problem of clogged ATM lines did not materialize during the Citibank pilot program of the new ATM.

The Examiner found that the Citibank ATM disclosed in LA Times inherently includes the banking functions of account access, funds transfer,

1 cash, receipt and statement dispensing, and inherently possesses all normal
2 components and component interrelationships of an ATM machine such as a
3 card reader, currency output device and currency sheet dispenser, a receipt
4 output device including a receipt sheet dispenser and a computer in operative
5 connection with the output devices and the currency sheet dispensers (Ans.
6 3-4).

7 An ATM determines the entity with which the customer operating the
8 machine has an account by determining which bank the customer has an
9 account with. An ATM provides, through an output device on the ATM,
10 at least one output uniquely corresponding to the entity with which the
11 customer has an account by providing, for example, a receipt after a banking
12 transaction or in response to a balance inquiry.

13 Infoworld discloses that NCR has developed enhancements to its Top
14 End middleware. A Java client was delivered to the Top End transaction-
15 processing monitor. The Top End client code runs on PCs and makes one
16 or 10,000 machines look as if they are local to a user's computing resource.
17 The client code which runs on PCs is downloaded into the user's web
18 browser to establish a direct link to the Top End back-end application,
19 thereby setting up a private TCP/IP connection that makes the user's
20 computer look as if it is a local ATM system. The web browser in Infoworld
21 is located in the user's computer, not in the ATM,

22 Anderson discloses a system for on-line financial services which uses
23 a browser interface (col. 2, ll. 40 to 47). Anderson does not disclose that the
24 browser interface is in operative connection with an ATM.

1 PRINCIPLES OF LAW

2 When the claimed and prior art products appear to be identical or
3 substantially identical, the Examiner can require an applicant to prove
4 that the prior art product does not necessarily or inherently possess the
5 characteristics of the claimed product. See *In re Best*, 562 F.2d 1252, 1255
6 (CCPA 1977); see also *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990)
7 (“[W]hen the PTO shows sound basis for believing that the products of the
8 applicant and the prior art are the same, the applicant has the burden of
9 showing that they are not.”). As stated in *In re Fitzgerald*, 619 F.2d 67, 70
10 (CCPA 1980) (quoting *In re Best*, 562 F.2d at 1255):

11
12 ANALYSIS

13 *Anticipation by LA Times*

14 We are not persuaded of error by the Examiner by Appellants’
15 argument that Examiner’s contention that the Citibank ATM described in
16 LA Times is considered to possess all normal components and component
17 interrelationships of an ATM machine is based on improper speculation.
18 The Examiner has found that LA Times inherently discloses an ATM that
19 determines data corresponding to an entity with which a customer operating
20 the machine has an account and provides at least one output uniquely
21 corresponding to the entity with which the customer has an account. As we
22 found above, an ATM performs these steps by identifying the bank with
23 which the customer has an account and providing a receipt in response to a
24 banking transaction or inquiry. The Examiner has a sound basis for finding
25 that the Citibank ATM described in LA Times performs these steps, as they

1 are steps that are traditionally performed by an ATM. We do not agree with
2 the Appellants that there would be no need to determine the entity with
3 which the customer has an account because the machines only work for
4 Citibank customers. LA Times does not state that the Citibank ATMs are
5 atypical in that they do not work with customers with accounts in other
6 banks. Appellants argue that the Citibank ATM described in LA Times is
7 not a typical ATM with normal components because the ATM is specially
8 designed. We do not agree. While LA Times does disclose that the
9 Citibank ATM is specially designed to include brokerage services, it
10 nonetheless is described as a typical ATM. For example, LA Times states
11 that the problem anticipated by Wells Fargo of regular banking customers
12 waiting in line for the ATM behind someone with a large portfolio did not
13 materialize during Citibank's pilot program. As such, the Examiner had a
14 sound basis for finding that the Citibank ATM described in LA Times was a
15 typical ATM which determines the entity with which the customer has an
16 account and provides an output that uniquely corresponds to the entity with
17 which the customer has an account. Since the Examiner has a sound basis
18 for finding that these steps are inherently performed by the Citibank ATM
19 described in LA Times, the burden shifted to the Appellants to prove that the
20 Citibank ATM did not perform these steps. The Appellants have not
21 provided any evidence that these steps are not inherent in the Citibank ATM.
22 Therefore, the burden is not met.

23 In view of the foregoing, we will sustain the Examiner's rejection of
24 claim 1.

1 We will also sustain the rejection as it is directed to claims 2 to 4, 28
2 and 29 because the Examiner has a sound basis for finding that the Citibank
3 ATM described in LA Times, like a typical ATM, includes a card reader that
4 reads indicia on a bank card; provides a visual output corresponding to the
5 entity; and includes a cash dispenser and the Appellants have not provided
6 evidence that this is not the case.

7 We will not sustain this rejection as it is directed to claim 5 because
8 the Examiner has not established that LA Times describes processing at least
9 one document through a browser. In fact, the Examiner admits that LA
10 Times is silent on whether a browser is used in the Citibank ATM (Ans. 5).
11 In addition, the Examiner has made no findings regarding whether the
12 Citibank ATM disclosed in LA Times inherently includes a browser.

13 In view of the foregoing, we will not sustain this rejection as it is
14 directed to claim 5 and claims 6 to 7 dependent thereon. We will also not
15 sustain this rejection as it is directed to claims 8 to 27, 30 to 32 because each
16 of these claims requires the use of a browser.

17
18 *Obviousness in view of LA Times*

19 We will sustain the rejection as it is directed to claims 1 to 4, 28 and
20 29 because as we stated above there is sound basis to find that the Citibank
21 ATM described in LA Times inherently includes the elements and steps
22 recited in these claims. In addition, as LA Times discloses a Citibank ATM,
23 LA Times suggests an ATM that includes the elements recited in these
24 claims as the steps and elements are typical in an ATM.

1 We will not sustain the rejection directed to claims 5 to 27 and 30 to
2 32 because each of these claims requires the use of a browser which is
3 neither disclosed expressly or inherently or suggested by LA Times.

4
5 *Obviousness in view of LA Times and Infoworld or Anderson*

6 The Examiner relies on Inforworld and Anderson for teaching a
7 browser interface through which an ATM functions. However claims 1 to 4,
8 28 and 29 do not recite a browser. As such, we will sustain the rejections as
9 directed to these claims for the reasons stated above in our discussion of the
10 anticipation and obviousness rejections of these claims based on the
11 teachings of LA Times alone.

12 We will also sustain the rejection of claim 5 over LA Times in view of
13 Infoworld. Claim 5 generally recites “a browser operating in a computer in
14 operative connection with an automated banking machine.” We found that
15 Infoworld discloses that the client code which runs on PCs is downloaded
16 into the user’s web browser to establish a direct link to the Top End back-
17 end application, thereby setting up a private TCP/IP connection that makes
18 the user’s computer look as if it is a local ATM system. The language of
19 claim 5 is thus sufficiently broad enough to encompass the off-site computer
20 which, has the browser, to be in operative connection with the ATM through
21 its TCP/IP connection. We will also sustain this rejection as it is directed to
22 claims 6 and 7 which are dependent on claim 5 because the Appellants do
23 not argue the separated patentability of these claims. We note that
24 Appellant's statements directed to claims 6 and 7 merely restate the
25 limitations of the claims and state that they are not taught by the art. We do

1 not consider Appellant's statements regarding claims 6 and 7 to be a separate
2 argument for patentability under 37 C.F.R. § 41.37 (c)(1)(vii).

3 Claims 8 and 19, and claims 9 to 18, 20 to 27, 30 to 32 dependent
4 thereon require that the browser is included in the banking machine. We
5 have found the web browser in Infoworld is located in the user's computer,
6 not in the ATM, since the Examiner has not provided any reasons to the
7 contrary. As such, Infoworld does not disclose a browser in the ATM.
8 Therefore, we will not sustain the rejection of claims 8 to 27, 30 and 32 over
9 LA Times in view of Infoworld.

10 In addition, we agree with the Appellant that Anderson does not
11 disclose or suggest an ATM or that the described browser is in operative
12 connection to an ATM. As such, we will not sustain the rejection of claims 5
13 to 27 and 30 to 32 as being unpatentable over LA Times in view of
14 Anderson.

15 CONCLUSION OF LAW

16 On the record before us, Appellants have shown that the Examiner
17 erred in rejecting claims 8 to 27 and 30 to 32. The Appellants have not
18 shown that the Examiner erred in rejecting claims 1 -7, 28 and 29.

19 AFFIRMED-IN-PART

20
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